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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,954	12/19/2001	Frank Venegas JR.	IDS-14602/i4	2646

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EXAMINER

SLACK, NAOKO N

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/027,954

Applicant(s)

VENEGAS, FRANK

Examiner

Naoko Slack

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

In view of Applicant's Amendment A received July 3, 2003, claim 5 has been cancelled as requested, and claim 1 has been amended to include the limitations of claim 5. However, Applicant's Amendment to the claims does not place the case in condition for allowance as no claims were indicated with allowable subject matter in the previous Office Action.

Furthermore, Applicant's Amendment does not correct deficiencies to the Information Disclosure Statement, objections to the Specification, and lack of antecedent basis. As no arguments to the first Office Action were presented, the basic content of the first Office Action is reiterated in this Final Action.

#### **Information Disclosure Statement**

The information disclosure statement filed May 6, 2002 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

#### ***Specification***

The disclosure is objected to because of the following informalities: On page 5, line 9, "present" should be - - prevent - -.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o): In claim 1,

Art Unit: 3635

line 10, " saddle weld" is not disclosed in the specification. For purposes of examination, it is assumed that saddle weld connections are dry connections at intersecting tubes, wherein the contact surface of the tubes comprise a saddle shaped cut-out, as described in US Patent 5,370,368 .

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, "a saddle weld" is not disclosed in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the loading platform" in lines 7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,261,647 to Venegas, Jr. et al. in view of US Patent 5,370,368 to Terrels et al.

Claims 1 and 2:

Venegas, Jr. et al. discloses a guard rail assembly comprising a pair of vertical metal side members (22, Figure 2) covered by polymeric sheathing (26 and 30, Figure 2), a horizontal metal member (50) covered by polymeric sheathing (54) spanning the two vertical members, the horizontal member has a length that extends beyond the outermost extent of the vertical side members. The vertical and horizontal members are attached by way of removable fastener (38).

While Venegas, Jr. et al. does not disclose that the horizontal and vertical rails are connected with a saddle weld, Terrels et al. shows a composite plastic and metal handrail assembly and discloses that the horizontal and vertical rails can be connected

by saddle welding (column 2, lines 60-63) to form a seamless and strong connection. In view of Terrels et al., it would have been obvious for one of ordinary skill in the art to connect the rails of Venegas Jr. et al. with saddle welds to improve the outward appearance and strength of the guard rail (column 6, lines 34-38) and also permits disassembly of the components (column 6, lines 6-10, 23-28). Venegas Jr. et al. is motivated to provide guardrails that can be assembled and disassembled, with the strength of steel and energy absorbing, low maintenance benefits of plastic (column 1, lines 10-26).

Claim 4:

Terrels et al. also teaches attachment of the vertical side members and horizontal member using a removable fastener (column 4, lines 1-11).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,261,647 to Venegas, Jr. et al. in view of US Patent 5,370,368 to Terrels et al. as applied to claim 1 and further in view of US Patent 5,354,037 to Venegas, Jr.

Claim 3:

In the guard rail assembly of Venegas, Jr. et al., the horizontal member extends beyond the outermost extent of the vertical side members. Venegas, Jr. et al. does not show the vertical side members with a length that extends beyond the upper extent of the horizontal member; however, such an arrangement is shown in the guard rail system of US Patent 5354037. In view of US Patent 5354037, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify

the guard rail of Venegas, Jr. et al. such that the vertical members extend beyond the outermost extent of the horizontal members to simulate the appearance of post and rail, a popular fencing style.

### **FINAL ACTION**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose telephone number is (703) 305-0315. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703) 308-0839. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
NS

  
Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600